REMARKS/ARGUMENTS

In response to the Office Action dated March 5, 2004, claims 1, 2, 5 17 and 20 are amended. Claims 1-9 and 17-23 are now active in this application. No new matter has been added.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 103

Claims 1-9 and 17-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yano et al. (USPN 6,031,9410 in view of Lanne et al. (USPN 4,663,658), for the reasons substantially of record.

The rejections are respectfully traversed.

The Examiner responds to the arguments in the Amendment dated December 19, 2003 by referring to portions of the reference that she contends evince that Yano et al. suggests displaying an image of a 3-D shape model as a guide image, using the display as guide for shooting the object, using the displayed 3D model to confirm that the desired three-dimensional data is obtained, and inputting images while sequentially monitoring the displayed 3-D shape of the object to be measured. However, even when the portions identified by the Examiner are considered, there is still nothing in the disclosure of Yano et al., that discloses or suggests displaying an image of a three-dimensional shape model as a guide image and then performing framing so that the guide image is overlapped on an image of the object image that corresponds to the guide image. This overlapping is clearly disclosed, for example, in Fig. 6C of the present application where the guide image GP2 is displayed as overlapping monitor image QP.

As admitted by the Examiner, Yano et al. "does not expressly disclose displaying the image to perform framing so that the guide image is overlapped on a image of the object before shooting the object" (see second full sentence on page 3 of the Office Action). However, more importantly, there is no recognition in Yano et al. for any realistic reason to performing such overlapping when performing framing. As noted in the previous response, the description in Yano et al. concerning framing is that a user determines ***framing*** while observing the displayed image sensed by camera 2, ***so that the object to be measured is located at nearly the center of the window*** 32, and thereafter, he or she presses a shutter. As noted further in the previous response, use of a three-dimensional shape model as a guide image used in framing, or when performing framing, which includes overlapping of the guide image corresponding to the three-dimensional shape model of the three-dimensional data inputted from a part of the object with an image of the object image that corresponds to the guide image, is neither contemplated nor necessary for the arrangement of Yano et al. to generate the three-dimensional model of the object to be measured. The framing that is contemplated in Yano et al. is clearly merely ***to locate the object to be measured in the center of the finder window 32*** (see FIG. 3). This framing has nothing to do with using a guide image, which is an image of a three-dimensional shape model having a shape substantially identical to the object displayed/to be shot.

In establishing the requisite motivation, it has been consistently held that both the suggestion and the reasonable expectation of success must stem from the prior art itself, as a whole. ***In re Vaeck***, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); ***In re Fine***, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); ***In re Dow Chemical Co.***, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

Applicants stress that the requisite motivation to support the obviousness conclusion is not an abstract concept, but must stem from the prior art as a whole to impel one having ordinary skill in

the art to modify a reference or combine references with a reasonable expectation of successfully achieving some particular realistic objective. See, for example, ***In re Gyurik***, 596 F.2d 1012, 201 USPQ 552 (CCPA 1979). Consistent legal precedent admonishes against the indiscriminate combination of prior art references. ***Carella v. Starlight Archery***, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986); ***Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.***, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); ***ACS Hospital Systems, Inc. v. Montefiore Hospital***, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984); ***In re Ehrreich***, 590 F.2d 902, 200 USPQ 504 (CCPA 1979).

The Examiner cites Lanne et al. as teaching that it is known to perform framing so that the guide image is overlapped on the object image (Abstract). However, as noted in the previous response also, Lanne et al. discloses a process and a device for assisting the manual positioning of workpieces ***to be machined and/or assembled***, in order ***to simplify machining and assembly***, by eliminating the corresponding tools or the prior tracing or workpieces to be positioned. Such purpose of Lanne et al. (***to simplify machining and assembly***) has no relationship to the forming of the three-dimensional model disclosed in Yano et al. Thus, Lanne et al. is clearly directed to an nonanalogous art. ***In re Clay***, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992); ***Ex parte Dussaud***, 7 USPQ2d 1818 (BPAI 1988). Accordingly, it cannot be said that one having ordinary skill in the relevant art of obtaining three-dimensional information of an object (Yano et al.) would have been charged with knowledge of Lanne et al. Thus, the requisite motivation required to establish a *prima facie* case of obviousness is nonexistent.

In view of the absence of the requisite motivation, the Examiner has failed to articulate any logical reason why one having ordinary skill in the art would have been motivated to modify and/or combine the applied references to arrive at the claimed invention. Thus, it is not apparent whence stems the requisite motivation for one having ordinary skill in the art to zero in on the methodology

of Lanne et al. for assisting the manual positioning of workpieces ***to be machined and/or assembled***, in order ***to simplify machining and assembly***, then insert this methodology in the arrangement of Yano et al., which is concerned with generating the three-dimensional model of an object to be measured by sequentially adding the data of the three-dimensional model to a three-dimensional mode storage unit, and has no disclosure concerning manual positioning of workpieces ***to be machined and/or assembled***.

Recognizing, after the fact, that a modification would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. ***In re Warner***, 379 F.2d 1011, 154, USPQ 173 (CCPA 1967).

It is impermissible simply to engage in hindsight reconstruction of the claimed invention, using applicants' structure as a template and selecting elements from references to fill in the gaps. ***In re Gorman***, 18 USPQ2d 1885 (Fed. Cir. 1991).

The only apparent motivation of record for the proposed modification of the arrangement of Yano et al. with the methodology disclosed by Lanne et al. to arrive at the claimed inventions is found in Applicants' disclosure which, of course, may not properly be relied upon to support the ultimate legal conclusion of obviousness under 35 U.S.C. §103. ***Panduit Corp. v. Dennison Mfg. Co.***, 810 F.2d 1561, 227 1 USPQ2d 1593 (Fed. Cir. 1987). It is, therefore, respectfully submitted that the Examiner has not established the requisite motivation for the proposed combination of references to arrive at the claimed invention.

Finally, in Lanne et al., the image P′ displayed in screen 1, provided by camera 2, is not an image of a three-dimensional shape model based upon three-dimensional shape model data.

Image P′ is merely a two-dimensional (TV) image taken of workpiece P and a person of ordinary skill in the art would understand that image P′ is **NOT** an image of a three-dimensional shape model based upon three-dimensional shape model data. Thus, even if the methodology of Lanne et al. were somehow combined with the arrangement of Yano et al., the claimed invention would not result as the finder window 32 would shown a ***two-dimensional image (P′) of object (P)*** input by scanning camera 2 overlapping ***a stored image (p′) of a model (p) of the object (P)*** (see column 2, lines 35-45 of Lanne et al.), not ***an image of a three-dimensional shape model*** based upon three-dimensional shape model data overlapping on ***an image of the object***. The required image of the object is not an image of a **model** of the object.

In view of the above, withdrawal of the Examiner's rejection of claims 1-9 and 17-23 under 35 U.S.C. § 103 is respectfully solicited.

At any rate, the independent claims are amended to more clearly recite the features of the present invention.

Independent claim 1 is amended to recite:

> displaying on the monitor screen the image of the three-dimensional shape model on as a guide image for framing in order to perform registration for a subsequent shooting;

Independent claim 2 is amended to recite:

> a monitor for displaying images; ...
> a display controller for displaying on the monitor the three-dimensional model image as a guide image for framing, together with an image of the object that corresponds to the guide image, wherein
> during framing, the monitor is controlled to display the guide image overlapping on the image of the object that corresponds to the guide image.

Independent claim 5 is amended to recite:

displaying on the monitor screen an image of a three-dimensional shape model having a shape substantially identical to the object as a guide image for framing, the image of the three-dimensional shape model being based on a predetermined three-dimensional shape model data;

framing so that the image of the input portion is overlapped on the guide image;

Independent claim 17 is amended to recite:

displaying on the monitor screen, in accordance with the attribute information, the image of the three-dimensional shape model as a guide image for framing in order to perform registration for a subsequent shooting;

Independent claim 20 is amended to recite.

a display controller for displaying on the monitor, in accordance with the attribute information, the image of the three-dimensional shape model as a guide image for scaling in order to perform registration for a subsequent shooting.

With regard to claim 20, the recited scaling is describe with respect to the second input method, beginning at page 29, line 19. The Examiner fails to identify any portion of the applied prior art references that discloses "scaling".

CONCLUSION

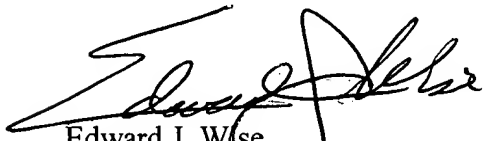
Accordingly, it is urged that the application, as now amended, overcomes the rejection of record and is in condition for allowance. Entry of the amendment and favorable reconsideration of this application, as amended, are respectfully requested. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY



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